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EXAMINER	
SU, EMILE	
ART UNIT	PAPER NUMBER
3685	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/517,444	OHMORI ET AL.	
	Examiner	Art Unit	
	EMILE SU	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 August 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *49-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *49-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/15/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. This Office Action is in response to communications filed on August 13, 2009. Claims 1-48 are cancelled. Claims 49-52 are newly presented.

2. Claims 49-52 are currently pending and are rejected.

Response to Arguments

3. Applicant's arguments with respect to claims 49-52 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

4. The information disclosure statement filed June 15, 2009 has been placed in the application file. But some of the information referred to therein has not been considered for failing to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Specifically, the foreign patent documents JP 9-44993, JP 11-167769, and JP 11-283327 are not considered since no translation has been provided.

Claim Rejections - 35 USC § 112, Second Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 49-52** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 49, Applicant recites "and when judging that the digital work is allowed to be used, that obtains the content information" in the limitations. The claim language, however, is unclear to one of ordinary skill in the art as the language does not explicitly point out whether obtaining step is result of the judging step or obtaining step is independent from the judging step (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). **Further regarding Claim 49**, Applicant recites "receives the content key" in line 34 of the claim. It is unclear whether the content key is encrypted or not. There is insufficient antecedent basis for this limitation in the claim. **Also regarding Claim 49**, Applicant recites "the read content information" in line 35 of the claim. The previous recitation of such information can not be found. There is insufficient antecedent basis for this limitation in the claim.

Regarding Claim 49, Applicant's recitation of the invention includes language for both an apparatus and a process in a single claim. Specifically, Applicant claims a "portable storage medium" while also claiming a process of using the component "by storing therein content information … stores rental disc identification information, as disc identification information"; claims a "rental-shop apparatus" while also claiming a process of using the component "securely writes … information .. when the portable semiconductor memory is mounted ... at a time of the user renting the portable storage medium"; claims a "a playback apparatus" while also claiming a process of using the

component "securely read … that judges … based on the read right information, and when judging that digital work is allowed … obtains the content information … and plays back the digital worked based on the content information … upon receipt of the instruction … reads the disc identification information … judges whether the read disc information is rental ... when judging that the read disc identification information is rental ... receives the content key ... and generates the digital work by decrypting … using the received content key". A single claim which purports to be both a product or machine and a process is ambiguous and is rejected for failing to particularly point out and distinctly claim the invention. See *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990).

As to Claim 50, see discussion of Claim 49 above. Claim 50 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a "playback apparatus" while also claiming a process of using the system "compares the first identification information … when the first identification information and second identification match, judges that the digital work … is allowed to be used".

As to Claim 51, see discussion of Claim 49 above. Claim 51 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a product or machine and a process. Specifically, Applicant claims a "portable semiconductor memory" while also claiming a process of using the system "allows … to write the right information only when the mutual authentication is successful".

As to Claim 52, see discussion of Claim 49 above. Claim 52 also fails to particularly point out and distinctly claim the invention as the claim purports to be both a

product or machine and a process. Specifically, Applicant claims a "portable semiconductor memory" while also claiming a process of using the system "allows … to read the right information only when the mutual authentication is successful".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 49-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., U.S. Patent No. 6,236,971 B1 (hereinafter Stefik) in view of Ishiguro et al., U.S. Patent No. 6,256,391 B1 (hereinafter Ishiguro).

With respect to Claim 49, Stefik discloses:

a portable storage medium that stores the digital work by storing therein content information (see Stefik, col. 14 lines 15-25; also see col. 7 lines 14-46 and col. 30 line 14 through col. 32 line 22) that is generated by encrypting the digital work based on a content key (see Stefik, col. 9 lines 39-54), and that stores rental disc identification information, as disc identification information, indicating that the portable storage medium is a disc for rental (see Stefik, col. 41 lines 8-13; also see col. 9 lines 55-67, col. 13 lines 49-65, and col. 31 lines 41-64);

a portable semiconductor memory that has an area for securely storing information (see Stefik, col. 31 lines 6-15; also se col. 7 lines 47-65 and col. 14 lines 5-25);

a rental-shop apparatus that generates right information relating to a right to use the digital work stored by the portable storage medium (see Stefik, col. 11 lines 45-53), and that securely writes the generated right information (see Stefik, col. 9 lines 39-54) to the area of the portable semiconductor memory (see Stefik, col. 31 lines 6-15; also se col. 7 lines 47-65 and col. 14 lines 5-25); and

a playback apparatus that receives an instruction from the user to play back the digital work (see Stefik, col. 35 line 65 through col. 6 line 33; also see col. 7 lines 47-65 and col. 8 lines 39-59), that securely (see Stefik, col. 26 lines 58-64) compares the

generated right information from the area of the portable semiconductor memory (see Stefik, col. 30 lines 58-67; also see col. 30 line 50 through col. 32 line 5), that judges whether the digital work is allowed to be used, based on the read fight information, and when judging that the digital work is allowed to be used (see Stefik, col. 30 line 14 through col. 32 line 22; also see col. 7 lines 14-46 and col. 14 lines 5-25), that obtains the content information from the portable storage medium (see Stefik, col. 34 line 16 through col. 35 line 4; also see col. 14 lines 15-25) and plays back the digital work based on the content information (see Stefik, col. 8 lines 39-59; also see col. 7 lines 47-65 and col. 35 line 65 through col. 36 line 33),

wherein the rental-shop apparatus securely writes the generated right information including an encrypted content key into the area of the portable semiconductor memory, the encrypted content key being generated by encrypting the content key using a device key (see Stefik, col. 28 lines 52-55);

wherein the portable semiconductor memory includes the device key prestored in the area, the device key being unique to the portable semiconductor memory (see Stefik, col. 27 lines 45-49), and includes a decryption unit operable to decrypt the encrypted content key stored in the area using the device key stored in the area to generate the content key, and output the generated content key (see Stefik, col. 28 lines 41-62), and

wherein the playback apparatus, upon receipt of the instruction from the user to play back the digital work (see Stefik, col. 35 line 65 through col. 6 line 33; also see col. 7 lines 47-65 and col. 8 lines 39-59), reads the disc identification information from the portable storage medium (see Stefik, col. 31 lines 16-29 and lines 41-64; also see col. 20

line 60 through col. 21 line 8), and judges whether the read disc information is rental disc identification information or sales disc identification information (see Stefik, col. 31 lines 16-29), and when judging that the read disc identification is rental disc identification information, receives the content key from the portable semiconductor memory and generates the digital work by decrypting the read content information using the received content key (see Stefik, col. 38 lines 7-9).

While Stefik discloses comparing the rights, Stefik does not specifically disclose a function of reading rights. Official Notice is taken that it is old and well known in the art to read information in order to make a comparison, because reading the information prevents corruption of the original source of the information.

Stefik does not specifically disclose encrypting content using a content key. Stefik dose disclose encryption using an encrypting key (see Stefik, Column 28 Lines 41-62). It would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt content using an encryption key, because encryption keys are small and easy to transfer.

Stefik does not explicitly disclose "when the portable semiconductor memory is mounted to the rental-shop apparatus at a time of the user renting the portable storage medium" and "wherein, when the digital work stored in the portable storage medium is played back, the portable semiconductor memory and the portable storage medium are mounted in the playback apparatus". Ishiguro does teach semiconductor memory mounted an apparatus and portable storage medium is mounted to the apparatus (see Ishiguro, col. 5 lines 39-56). A predictable result to one of ordinary skill in the art, in

light of Ishiguro, would have been to have semiconductor memory and portable storage medium mounted on an apparatus, because this reduces the chance of movable parts being lost.

As to Claim 50, Stefik and Ishiguro disclose the invention substantially as claimed. Stefik further discloses:

wherein the portable storage medium stores first identification information identifying the digital work in correspondence with the content information (see Stefik, col. 41 lines 8-13; also see col. 9 lines 55-67 and col. 13 lines 49-65),

wherein the rental-shop apparatus writes, into the area, the right information including second identification information for identifying the digital work (see Stefik, col. 41 lines 34-49; also see col. 25 lines 34-41), and

wherein the playback apparatus compares the first identification information stored in the portable storage medium with the second identification information included in the read right information, and when the first identification information and the second identification information do not match, judges that the digital work obtained by decrypting the content information corresponding to the first identification information is allowed to be used (see Stefik, col. 41 lines 34-49; also see col. 14 lines 5-25 and col. 25 lines 34-41).

While Stefik discloses checking for a match against invalid authorization ID to prevent authorization, Stefik does not specifically disclose checking for a match against a valid authorization ID to allow authorization. A predictable result for one of ordinary skill in the art at the time of the invention would have been to compare against a valid

authorization ID list, because it is easier to maintain a valid list by a issuer since the issuer has no control of how many invalid ID are generated by illicit third-parties (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

As to Claim 51, Stefik and Ishiguro disclose the invention substantially as claimed. Stefik further discloses, wherein the portable semiconductor memory performs mutual authentication with the playback apparatus (see Stefik, col. 27 line 20 through col. 28 line 40), and allows the playback apparatus to read the right information only when the mutual authentication is successful (see Stefik, col. 30 lines 15-26).

However, Stefik does specifically disclose mutual authentication with a rental-shop apparatus and write only when authentication is successful. A predictable result for one of ordinary skill in the art, in light of Stefik, would have been to perform the same mutual authentication with a rental-shop apparatus and restrict the apparatus's actions (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)), because this prevents unauthorized rentals being made.

As to Claim 52, Stefik and Ishiguro disclose the invention substantially as claimed. Stefik further discloses, wherein the portable semiconductor memory performs mutual authentication with the playback apparatus (see Stefik, col. 27 line 20 through col. 28 line 40), and allows the playback apparatus to read the right information (see Stefik, col. 9 lines 55-67) only when the mutual authentication is successful (see Stefik, col. 30 lines 15-26).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kambayashi et al., U.S. Patent No. 6,477,649 B2. Prior art discloses limiting content use through licensing and encryption.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILE SU whose telephone number is (571) 270-7040. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CALVIN L. HEWITT can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EMILE SU/
Examiner, Art Unit 3685
December 5, 2009

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685